

### **REMARKS**

Claims 1-20 are now in the application. No claims have been amended by this Response. Claims 3-11 and 13-20 have previously been withdrawn by the Examiner. No new matter has been added.

Claims 1, 2 and 12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,827,508 to Tanner et al. in view of U.S. Patent No. 4,640,943 to Meguro et al. and further in view of U.S. Patent No. 5,939,518 to Mazo et al.

As appreciated by the Examiner, Tanner fails to suggest a surface coating comprising polyasparaginic acid. Instead, the Office Action relies on Meguro for suggesting this feature. However, Meguro fails to suggest polyasparaginic acid with molecular weight  $M_w$  of from 1000 to 7000, as recited in claim 1. The Office Action relies on Mazo for suggesting this feature.

The Office Action asserts at page 6, lines 16-20, that using the polyasparaginic acid to decrease the particle size of the metal oxide particles is not recited in the pending claims. Applicants respectfully submit that the method claims have been previously withdrawn. The pending product claims recite a molecular weight that allows precipitating metal oxide particles with the recited particle size range.

Moreover, the Office Action relies on Tanner for a suggestion of a zinc oxide particle size of from about 10 to 10,000 nm, i.e., three orders of magnitude. At page 7, lines 7-10, the Office Action asserts that a skilled artisan would expect that a high molecular weight polyaspartic acid results in an increased particle size. Does this also mean a skilled artisan would expect that a low molecular weight results in coated particles having a small particle size? Further, would a skilled artisan expect that using aspartic acid, i.e., the compound actually suggested in Tanner, result in a coating of elemental silicon atoms?

As set forth in the enclosed Declaration under 37 CFR 1.132, it was not known to the inventors that using the preferred molecular weight of from 1000 to 7000 g/mol would result in the preferred particle size before conducting the actual experiment. Moreover, it was also not

known that precipitating metal oxide particles in the presence of polyasparaginic acid would influence the particle size of the precipitated coated particles.

In addition, the argument in the Office Action cannot be reconciled with the experimental data set forth in the enclosed Declaration. Specifically, the average particle size decreases slightly from 172 to 170 nm by using polyasparaginic acid having a molecular weight of 5,800 instead of 4,000. Based on the assertion in the Office Action, the particle size should have been greater by using polyasparaginic acid having a molecular weight of 5,800 g/mol.

Claims 1 and 2 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0033270 to Kropf et al. in view of Mazo.

As appreciated by the Examiner, Kropf fails to suggest the recited molecular weight range of polyasparaginic acid. Instead, the Office Action relies on Mazo for suggesting this feature of independent claim 1.

The application of Mazo fails for the same reasons set forth above.

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Applicants concurrently herewith submit the requisite fee for a Request for Continued Examination. Applicants believes no additional fee is due with this response. However, if any such additional fee is due, please charge our Deposit Account No. 22-0185, under Order No. 12810-00346-US1 from which the undersigned is authorized to draw.

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Respectfully submitted,

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